

**REMARKS**

**Summary of the Office Action**

The disclosure is objected to because of alleged informalities.

A new title is required because the title is allegedly “not descriptive.”

Claim 6 stands rejected under 35 U.S.C. § 112, second paragraph as allegedly lacking proper antecedent basis for a claimed feature.

Claims 1-3, 8 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gaalema (U.S. Patent No.: 4,507,674) (hereinafter “Gaalema”).

Claims 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaalema and further in view of Yutaka et al. (JP 3-104287) (hereinafter “Yutaka”).

Claim 7 stands rejected under 35 U.S.C. § 1103(a) as being unpatentable over Gaalema and further in view of Fujii et al (U.S. Patent No.: 6,933,489) (hereinafter “Fujii”).

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaalema and further in view of Nunogaki et al (U.S. Patent No.: 5,602,384) (hereinafter “Nunogaki”).

**Summary of the Response to the Office Action**

Applicant has amended claims 1 and 6 to differently describe embodiments of the disclosure of the instant application and/or to improve the form of the claims. Accordingly, claims 1-20 remain currently pending with claims 1-10 currently under consideration and claims 11-20 currently withdrawn from consideration. Applicant has also amended the title and various portions of the specification in response to the requirements in the Office Action.

**Objections to the Disclosure**

The disclosure is objected to because of alleged informalities. Applicant has amended various portions of the specification in response to the Examiner's comments at page 2, section 3 of the Office Action. Accordingly, withdrawal of the objections to the disclosure is respectfully requested. In the event that any outstanding informalities might still exist, the Examiner is respectfully requested to point out, in the next Office Communication, specifically which page(s) and line number(s) might include such informalities.

**Requirement for a New Title**

A new title is required because the title is allegedly "not descriptive." In response, Applicant has replaced the previous title with a new amended title by generally incorporating the Examiner's helpful suggested new title at page 3, section 5 of the Office Action. Accordingly, withdrawal of the requirement for a new title is respectfully requested.

**Rejection under 35 U.S.C. § 112, second paragraph**

Claim 6 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly lacking proper antecedent basis for a claimed feature. Applicant has amended claim 6 to improve the form of the claim. Applicant respectfully submits that claim 6, as amended, fully complies with the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, second paragraph be withdrawn.

**Rejection under 35 U.S.C. §§ 102(b) and 103(a)**

Claims 1-3, 8 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gaalema. Claims 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaalema and further in view of Yutaka. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaalema and further in view of Fujii. Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gaalema and further in view of Nunogaki.

In the Office Action, the Examiner asserted out that a light transmitting layer defined in claim 1 corresponds to a substrate 12 disclosed in Gaalema. However, Applicant respectfully traverses such an assertion because the substrate 12 of Gaalema is a “substrate (base plate)” which is used for epitaxial growth of a semiconductor layers 18 and 20. That is, Applicant respectfully submits that the substrate 12 of Gaalema apparently corresponds to a semiconductor substrate 51 of the present invention which is removed by etching or CMP etc., after a step of providing a light transmitting layer 1 on a multilayer structure. In other words, Applicant respectfully submits that it is apparent that the substrate 12 of Gaalema does not correspond to the light transmitting layer described in newly-amended independent claim 1 of the instant application:

Further, Applicant respectfully submits that the substrate 12 in Gaalema is a substrate on which the multilayer structures constituting the semiconductor layers 18 and 20 are grown but also a layer having a light transmitting function.

However, Applicant respectfully submits that Gaalema does not disclose, nor even suggest, the provision of another light transmitting layer that is different from a substrate on which the multilayer structure is grown on a surface of the multilayer structure (corresponding to first main face as defined in the amended claim 1) opposite to a surface of the multilayer

structure (corresponding to second face as defined in the amended claim 1) on which the substrate 51 of the multilayer structure is temporarily provided. Accordingly, Applicant respectfully submits that Gaalema does not disclose, nor even suggest, the provision of a layer covering the first electrode and making the first main face of the multilayer structure flatten when the light transmitting layer is provided on the multilayer structure LS in the manner specifically described in the advantageous combination of features of newly-amended independent claim 1 of the instant application.

Accordingly, Applicant respectfully asserts that the rejections under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn because Gaalema does not teach or suggest each feature of independent claim 1 of the instant application. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)."

Furthermore, Applicant respectfully asserts that the dependent claims 2-10 are allowable at least because of their dependence from independent claim 1, and the reasons discussed previously. With regard to the additionally applied reference to Yutaka with regard to dependent claims 4-6, Applicant respectfully submits that this additionally applied reference does not cure the deficiencies discussed previously with regard to Gaalema. With regard to the additionally applied reference to Fujii with regard to dependent claim 7, Applicant respectfully submits that this additionally applied reference does not cure the deficiencies discussed previously with regard to Gaalema. With regard to the additionally applied reference to Nunogaki with regard to dependent claim 10, Applicant respectfully submits that this additionally applied reference does

not cure the deficiencies discussed previously with regard to Gaalema. As pointed out by MPEP § 2143.03, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.’ In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).”

### CONCLUSION

In view of the foregoing, Applicant submits that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant’s undersigned representative to expedite prosecution. A favorable action is awaited.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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